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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: David Newsome

DATE: July 22, 2003

SERIAL NO.: 09/634,054

GROUP ART UNIT: 3763

FILED: 8 August 2000

EXAMINER: Hayes, Michael J.

FOR: "DILATION ENHANCER"

ATTORNEY DOCKET NO.: P00005US (53783.1P)

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
BRIEF OF APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

On 17 January 2003, the Examiner finally rejected Claims 27-29, 31, and 34 of the above-referenced patent application. A Notice of Appeal was filed on 19 May 2003, and was received by the USPTO on 22 May 2003. This brief, required by 37 C.F.R. § 1.192(a), is due by 22 July 2003 (see 37 C.F.R. § 1.8(a)(2) and MPEP § 512 (Eighth Edition First Revision (E8R1) 02/2003)); it is in the form required by 37 C.F.R. § 1.192(c).

CERTIFICATE OF MAILING

I hereby certify that **the original and two copies** of this Appeal Brief are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 22, 2003.

Seth M. Nehrbass, Reg. No. 31,281

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(1) REAL PARTY IN INTEREST:

The real party in interest is David Newsome, M.D.

(2) RELATED APPEALS AND INTERFERENCES:

There are no related appeals or interferences.

(3) STATUS OF CLAIMS:

Claims 1-26, 32, and 33 have previously been cancelled. Claims 27-31 and 34-36 are pending. Claims 27-29 and 30 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Beck in view of applicant's disclosure. Applicant respectfully traverses this rejection.

The rejection of Claims 27-29 and 30 is being appealed.

(4) STATUS OF AMENDMENTS:

No amendments have been filed after the final rejection.

(5) SUMMARY OF INVENTION:

The present invention as claimed is similar to the invention claimed in applicant's US Patent No. 6,101,411, but specifies that the power source is light-activated.

As suggested by MPEP § 1206, Applicant has read some of the appealed claims on the specification and drawings. These claims follow.

27. An apparatus 110 (Figs. 4-6 - see page 7, lines 12-33) for performing electrophoresis on a patient's eye comprising:

a) a composite contact lens structure 140 that comprises an outer shell 141 having a concave surface and a convex surface;

b) a disposable lens member 142 that removably fits the shell at the concavity; and

c) the convex portion of the shell carrying an electrode 121, 122 for transmitting electrical current to the shell 141 and lens member 142;

a light-activated power source 120 for providing electricity to the electrode.

28. The apparatus of claim 27 wherein the lens member is soft (page 7, line 19).

31. The apparatus of claim 27, wherein the lens member is pre-medicated with a dilator drug or dilator reversal drug (page 7, lines 19 and 20).

(6) ISSUES:

(i) (There are no 35 U.S.C. § 112, first paragraph rejections.)

(ii) (There are no 35 U.S.C. § 112, second paragraph rejections.)

(iii) (There are no 35 U.S.C. § 102, second paragraph rejections.)

(iv) Are claims 27-29 and 30 patentable over Beck and applicant's disclosure under 35 U.S.C. § 103(a)?

(7) GROUPING OF THE CLAIMS:

The rejected claims do not stand or fall together. Based on the references cited and arguments made by the Examiner, the claims are grouped together in particular combinations in part (8) for convenience. Applicant reserves the right to regroup the claims or to argue the patentability of each claim individually should new references be cited or new arguments or rejections be made.

(8) ARGUMENT:

(i) (There are no 35 U.S.C. § 112, first paragraph rejections.)

(ii) (There are no 35 U.S.C. § 112, second paragraph rejections.)

(iii) (There are no 35 U.S.C. § 102, second paragraph rejections.)

(iv) Claims 27-29 and 30 are patentable over Beck and applicant's disclosure under 35 U.S.C. § 103(a).

Claims 27-29 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beck in view of applicant's disclosure. Applicant respectfully traverses this rejection.

Just because applicant disclosed in his patent application as filed that light-activated power sources are commercially available does not mean that it would be obvious to make the apparatus as claimed in Claim 27. There is no suggestion anywhere (other than in the present patent application) that one should use a light-activated power source to provide electricity to a device for performing electrophoresis. Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction.

CONCLUSION:

For the foregoing reasons, applicant respectfully submits that all claims remaining in the application are allowable. A Notice of Allowance is hereby respectfully requested.

TELEPHONE CONFERENCE INVITATION:

Should the Examiner or any member of the Board feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the

telephone number listed below.

PETITION FOR EXTENSION OF TIME:

Applicant hereby petitions the Commissioner under 37 C.F.R. § 1.136 for any extension of time necessary to render this Appeal Brief timely filed, and asks that the fee for any such extension be charged to Deposit Account No. 50-0694.

FEES:

A \$ 160.00 check for the fee required by 37 C.F.R. § 1.192(a) and § 1.17(f) is enclosed. Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

Respectfully submitted,



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(9) APPENDIX:

CLAIMS ON APPEAL:

27. An apparatus for performing electrophoresis on a patient's eye comprising:
 - a) a composite contact lens structure that comprises an outer shell having a concave surface and a convex surface;
 - b) a disposable lens member that removably fits the shell at the concavity; and
 - c) the convex portion of the shell carrying an electrode for transmitting electrical current to the shell and lens member;a light-activated power source for providing electricity to the electrode.
28. The apparatus of claim 27 wherein the lens member is soft.
29. The apparatus of claim 28 wherein the lens member is made of polyfilcon.
31. (amended) The apparatus of claim 27, wherein the lens member is pre-medicated with a dilator drug or dilator reversal drug.